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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,035	07/28/2003	Darryl C. Stein	G48-1386-1	9023
27123	7590	12/15/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P.			BLAKE, CAROLYN T	
3 WORLD FINANCIAL CENTER			ART UNIT	PAPER NUMBER
NEW YORK, NY 10281-2101			3724	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/631,035	<b>Applicant(s)</b> STEIN ET AL.	
	<b>Examiner</b> Carolyn T. Blake	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
     4a) Of the above claim(s) 7-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on September 15, 2005.
2. The objection to the disclosure is withdrawn in view of the amendment.
3. The objection to claim 1 is withdrawn in view of the amendment.
4. The text of those sections in Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

5. Applicant's election with traverse of Group I and Species I in the reply filed on March 30, 2005 is acknowledged. The traversal is on the ground(s) that (1) all groups of claims are properly presented in the same application; (2) undue diverse searching should not be required since all claims are in the same class; and (3) all claims should be examined together. This is not found persuasive. The examiner has properly shown one-way distinctness between the apparatus of Group I and the method of Group II, as detailed in the Office action dated March 1, 2005. Moreover, for a proper traversal of an election of species, Applicant is required to submit evidence or admit on the record that the species are obvious variants of each other. Applicant has not done this. Finally, undue diverse searching would be required for all of the species presented. Although all the claims may be classified in the same class, each species, apparatus, and method would require a unique search, consisting of different subclasses and text searches.

Nonetheless, if claim 1 is allowed and there is compliance with 35 USC 101 and 35 USC 112, rejoinder will be permitted in accordance with *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995). See MPEP 608.01(n).

The requirement is still deemed proper and is therefore made FINAL.

The examiner apologizes for inadvertently failing to address Applicant's traversal in the first Office action on the merits.

### ***Drawings***

6. The drawings are objected to because the relationship between FIG 1 and FIGS 2-4 is unclear. For example, it is not understood where the motor, magnet retainer, or pick up (FIG 2) is located in FIG 1. Further clarification is required.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

7. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearl (3,815,221) in view of Henninger (3,274,409), and in further view of Balamuth et al (3,086,288). Pearl discloses an apparatus for cutting sheet type work (30) comprising a blade (18) defining at least one sharpened edge; a frame (12) having a support surface (16) mounted thereon for carrying at least one layer of a sheet-type work material (30); a carriage (22) coupled to said frame (12) for movement back-and-forth there along in a first coordinate direction in response to commands issued from a controller (26); a cutter head (20) coupled to said carriage (22) for movement back-and-forth in a second coordinate direction also in response to commands issued from said controller (26), said second coordinate direction being approximately perpendicular to said first coordinate direction. Pearl fails to disclose the means for actuating the blade or a resonator assembly. However, Henninger discloses a resonator assembly including: a magnetically permeable beam (12); an element (20/21) coupled to said beam (12); a magnetic pickup (14) coupled to said beam (12); at least one discrete magnet (32) positioned proximate said pickup (14), said magnet (32) and said pickup (14) defining an air gap there between; resonating means for moving said at least one discrete magnet (32) relative to said pickup (14) to create an alternating magnetic field, thereby causing said pickup (14) to vibrate, which in turn cause said beam (12) and said element (20/21) to vibrate. Furthermore, Henninger discloses the resonating means

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includes: a magnet retainer (25) having a plurality of magnets (32) coupled thereto; a motor; said magnet retainer (25) being rotatably coupled to said motor (by shaft 7); and wherein rotation of said motor and thereby said magnet retainer (25) causes at least one magnet (32) to pass by said pickup (14) at a known frequency thereby generating an alternating magnetic flux that in turn causes said element (12) to resonate. Henninger discloses a mounting bracket (16/167, said beam (12) being attached to and cantilevered from said mounting bracket (16/17). The Henninger resonator assembly is fairly small in size and lightweight, while still being powerful and efficient (see. col. 1, lines 35-36 and lines 42-43). In addition, Balamuth et al disclose advantages for using a vibrating blade in cutting operations, particularly for cutting fabrics and leather. Balamuth et al disclose a vibrating blade requires less force (col. 1, lines 45-49) and creates a cleaner cut (col. 1, lines 53-56) than a blade that is not vibrating. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a small, lightweight, powerful, and efficient resonator assembly, as disclosed by Henninger, on the Pearl device for the purpose of vibrating the blade, which Balamuth et al disclose creates as clean cut with less force.

### ***Response to Arguments***

8. Applicant's arguments filed September 15, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Pearl, Henninger, and Balamuth are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem

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with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant states "Pearl is not pertinent to the claimed invention" (page 13). The examiner does not understand this statement, as it appears Applicant's FIG 1 is almost an exact replication of Pearl's FIG 1. In regards to the Henninger reference, the examiner agrees that this reference is not directed to cutting. However, the reference does teach a magnet means for actuating a device, which is clearly pertinent to problem with which Applicant was concerned. Certainly, the Pearl and Henninger references can be combined to show the invention as claimed, especially when Balamuth is provided as additional motivation. Again, the examiner agrees with some of Applicant's assertions regarding the differences between the Balamuth device and the claimed invention, but Balamuth is cited primarily to provide motivation for vibrating a cutting blade as claimed.

This application may contain patentable material, but this material has not been distinctly claimed so as to read over the prior art.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CB

CB

December 5, 2005



**Allan N. Shoap**  
**Supervisory Patent Examiner**  
**Group 3700**